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Remarks

Entry of the above-noted amendments, reconsideration of the application, and allowance of all claims are respectfully requested. Claims 1-4 are pending.

Applicant's arguments presented below focus on certain patentable differences between the invention as claimed and the applied references. However, it is not to be inferred that the failure to argue all differences between the claimed subject matter and the applied references constitutes acceptance of assertions made in the Office Action of alleged similarities between elements of the claimed subject matter and the applied references.

Claim Rejections - 35 U.S.C. §103

Claims 1-4 were rejected under 35 U.S.C. 103 as being unpatentable over U.S. Patent No. 4,899,373 (Lee) in view of U.S. Patent No. 6,317,484 (McAllister). Applicant respectfully traverses this rejection.

MPEP §706.02(j) states: "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." (Emphasis added.)

Claim 1

In accordance with the method of claim 1 a user call feature set is transferred from a home switch to a visiting switch that supports the subscriber while at any remote telephone line. The user call feature set is stored in a second database separate from the visiting switch. Upon

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receiving an incoming call that is redirected from the home switch to the visiting switch, the visiting switch retrieves the user call feature set from the second database each time an incoming call is received.

In the Office Action a combination of the teachings of Lee and McAllister was relied upon. More specifically, Lee was alleged to teach all of the required steps of claim 1 except the requirement of receiving the incoming call at a home switch and redirecting incoming call to a remote telephone line, for which McAllister was relied upon.

Lee does not teach that a visiting switch stores a user call feature set at a remote database, and does not teach that the visiting switch retrieves a user call feature set each time an incoming call is received at the visiting switch. In the Office Action the first database of claim 1 was said to be database 140 in Lee with the local memory 111 of a supporting switch of the remote line being equated to the second database. Clearly, the local memory 111 is not a separate database from the supporting switch. Further, the call feature information in Lee is downloaded by the TSPS 120 to local memory 111 of the local supporting switch so that this information does not have to be downloaded again. This is contrary to the requirement of claim 1. Therefore, the subject matter of claim 1 is not rendered obvious by Lee, McAllister, or the combination thereof.

Lee does not provide an enabling teaching with regard to handling incoming calls at a remote telephone line where a subscriber's call feature set of his home switch is made available at the remote telephone line. In the Office Action, reference was made to the abstract and column 1, line 64-68 of Lee with regard to incoming call teachings. The Abstract states that "personalized features will be immediately available on incoming and outgoing calls for a period of time specified by the subscriber." The bottom of column 1 mentions "allows features relating to incoming calls, such as call screening, to be applied to the temporary office phone." However, the mere identification of a feature or capability, without providing an enabling teaching of the subject matter, is insufficient to permit reliance upon the reference as prior art under 35 U.S.C. 102 and/or 103.

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"A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled." *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1354, 65 USPQ2d 1385, 1416 (Fed. Cir. 2003). See *Bristol-Myers Squibb v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1374, 58 USPQ2d 1508, 1512 (Fed. Cir. 2001) ("To anticipate the reference must also enable one of skill in the art to make and use the claimed invention.")

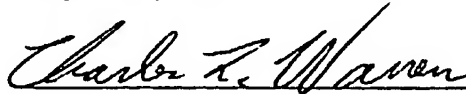
A review of the detailed description of Lee including the information contained in FIGs. 1-6 provides no teaching or suggestion to one of ordinary skill in the art with regard to how incoming calls could be processed to achieve temporary office phone features. All of the specific teachings of Lee are directed to initial registration of a user at a remote phone line and the handling of outbound calls made at the remote phone line by the user. FIGs. 4-6 provide a flow diagram explaining the "functions carried in the local exchange of FIG. 1"; column 2, lines 19-20. It is clear from steps 401 and 403 of FIG. 4 that the described process is for an outgoing call, e.g. receiving dial tone and the connection of the digit receiver would not occur if the subscriber were receiving an incoming call. Further in FIG. 5 and 6, it is clear that the described steps relate to the processing of an outbound call from the subscriber. The detailed description of the operation in Lee fails to provide one of ordinary skill in the art with any instructions or guidance on how to make or practice the use of temporary office phone features for incoming calls. It is well known to those skilled in the art that substantially different processing is accorded incoming calls from the processing required for outgoing calls. For example, a switch terminating a conventional inbound call is responsible for determining if the called line is busy, and if not, causing a ringing signal to be generated. A conventional switch would not first seek to determine if the called line was to be treated in accordance with a different set of rules. Because Lee provides no teaching that would enable one of ordinary skill in the art to make and practice the relied upon subject matter, Lee is not available as a prior art reference.

Since Lee does not meet the standards for use as a prior art reference for the subject matter it is relied upon as teaching, the rejection of claim 1 under 35 U.S.C. 103 based on Lee and McAllister should be withdrawn.

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In view of the above amendments and remarks, allowance of all claims pending is respectfully requested. If a telephone conference would be of assistance in advancing the prosecution of this application, the Examiner is invited to call applicants' attorney.

Respectfully submitted,

A handwritten signature in cursive script, reading "Charles L. Warren", written in dark ink.

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